

Notice of Allowability

Application No.

10/015,869

Examiner

Fozia M. Hamud

Applicant(s)

BAKER ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 07/29/2005.
2. ☒ The allowed claim(s) is/are 33, 38-40, 44-54, (now renumbered 1-15, respectively).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

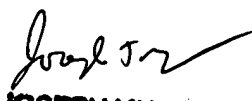
Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 07/29/2005 09/09/2004
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


JOSEPH MURPHY
PATENT EXAMINER

REASONS FOR ALLOWANCE:

1a. Applicants' arguments filed on 29 July 2005 is acknowledged.

Status of Claims:

1b. Claims 1-32, 34-37 and 41-43 have been cancelled. Claims 33, 38-40, 44-54 are pending and are in condition for allowance.

Information Disclosure Statement::

2a. The information disclosure statements filed 09 December 2004, was received and complies with the provisions of 37 CFR §§1.97 and 1.98. It has been placed in the application file and the information referred to therein has been considered as to the merits on 17 December 2004.

Priority:

3. Applicants submit that they rely on the gene amplification assay (Example 143) for patentable utility, which was first disclosed in U.S. Provisional Application No. 60/162,506, filed October 29, 1999, priority to which has been claimed in this application. As will be shown, the disclosure of the instant application, which is similar to that of the earlier-filed application (see Example 20, Provisional Application No. 60/162,506), provides the support required to establish utility for the nucleic acid encoding the PRO1293 polypeptide.

Withdrawal of previous Rejections:

4a. The rejections of claims 48-54 made under U.S.C. § 102 (a) as being anticipated by Baker et al., WO 200012708, published on March 9, 2000 or Robert Strausberg (10/20/2000) or Ansorge et al (02/18/2000), are withdrawn, because claims 48-54 are

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afforded the effective filing date (10/29/1999) which predates the dates that the references were published.

Claim 48 is drawn to an isolated nucleic acid molecule consisting of at least 20 nucleotide fragment of the nucleic acid of sequence of SEQ ID NO:76 or a complement thereof that specifically hybridizes under the recited conditions to SEQ ID NO:76 or complement, as such claim 48 is not drawn to a variant of SEQ ID NO:76, but claims a fragment of SEQ ID NO:76 or a complement thereof, and claims 49-54 add limitations of at least 50, 70, 90 and 100 nucleotides, respectively. Applicants' argument that a nucleic acid that consists of at least 20, 50, 70, 90 or 100 nucleotides of SEQ ID NO:76 or complement thereof, and which hybridizes to the nucleic acid of SEQ ID NO:76 or complement would be useful as probe to detect the expression of SEQ ID NO:76, is found persuasive.

Accordingly, claims 48-54 are allowable, since they are afforded the effective filing date of October 29 1999, which predates the published dates of the references.

Conclusion:

5. Claims 33, 38-40, 44-54 are free of prior art of record and are allowed.

Advisory Information:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia M. Hamud whose telephone number is (571) 272-0884. The examiner can normally be reached on Monday, Thursday-Friday, 6:00 am to 4:00 pm.

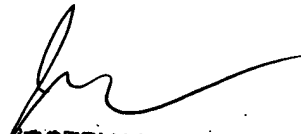
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda G. Brumback can be reached on (571) 272-0961. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fozia Hamud
Patent Examiner
Art Unit 1647
11 November 2005



JOSEPH MURPHY
PATENT EXAMINER